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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/759,721

01/12/2001

Ycong-Taeg Kim

SAM1.0082

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08/16/2006

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EXAMINER

BELIVEAU, SCOTT E

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,721

Applicant(s)

KIM, YEONG-TAEG

Examiner

Scott Beliveau

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 31 July 2006 have been fully considered but they are not persuasive.

With respect to applicant's arguments such that the "Banner Information" of the instant application is different from that of Butler et al., the examiner respectfully continues to disagree. The instant application as originally filled clearly sets forth that "Banner Information" is defined as contents in the form text, graphics, images, or any other type of audio visual information which is intended for commercial advertisement and can be presented to the user with any other type of digital television presentation (IA: Page 16, Line 14-16). Butler et al. discloses that "hyperlink overlays" are similar to documents or web pages [Para. 0022] that can be utilized for advertisements (Para. [0004] and [0046]) and can be displayed non-transparently to overlay the displayed video (Para. [0044]). The particularly argued steps are irrelevant. The particularly displayed overlay of Butler et al. is still contents in the form of text, graphics, images, or any other type of audio/visual information which is intended for commercial advertisement and can be presented to the user with any other type of digital information. "Banner Information" as defined within the specification is not limited to whether or not the overlays are rendered either in the foreground or the background of the video images or even how many steps might be necessary to view the information. "Banner Information" is broadly defined. Accordingly, applicant's arguments pertaining to Butler et al. failing to disclose "Banner Information" are still not deemed persuasive.

With respect to applicant's argument such that the Butler et al. reference fails to provide a combined digital signal, the examiner respectfully continues to disagree. Butler et al. explicitly discloses that "... In the case of digital satellite transmission ancillary data can be easily transmitted in digital form along with video and audio ... Protocols such as MPEG-2 already provides for incorporating ancillary digital data in packets that are downloaded with digital audio/video content using satellite transmission facilities ... " (Para. [0015]).

Ancillary data clearly falls into the realm of contents in the form of text, graphics, images, or any other type of audio/visual information which is intended for commercial advertisement and can be presented to the user with any other type of digital information when it is the disclosed 'hyerlink overlays'. The particular distribution of the video programming along with ancillary digital data is considered to meet the particular recitation of a "combined digital signal".

With respect to applicant's arguments that Butler does not disclose a "specialized receiver" rather than a general purpose computer, the examiner respectfully disagrees. Firstly, claim 1 does not recite a 'specialized receiver'. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Secondly, the cited passage does not appear to set any special definition with respect to what is meant by a 'specialized receiver'. A 'specialized receiver, in light of the specification, simply appears to be a digital television receiver that is capable of receiving/displaying both regular programming and supplemental 'Banner Information'. Butler et al. clearly discloses a type of digital television receiver either embodied within a broadcast enabled personal computer

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or a traditional enhanced television (Para. [0026] and [0028]) which is capable of receiving/displaying 'Banner Information' as previously discussed.

With respect to applicant's arguments regarding the Butler failing to teach a controller wherein information is displayed only upon user permission, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Butler reference was not relied upon for its teachings regarding the particular usage of a 'controller' displaying information based upon receiving a user's permission. As set forth in the rejection of record, the Watts reference was provided to teach this limitation.

With respect to applicant's arguments regarding the Watts failing to teach a 'controller that controls the presentation unit to display the Banner Information only', the examiner respectfully disagrees. The reference clearly discloses that when enabled the logic [141] controls the particular display of primary content (ex. video) with subsidiary data (ex. advertisement) (Col 5, Lines 56-58) and that the user enables or disables the logic [141]. A user who is enabling the display of subsidiary data is clearly 'giving permission' to the system to display the data.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837

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F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The instant application is in the field of digital television and video services (IA: Page 2, Lines 2-4). Butler et al. provides for the distribution of enhanced content with broadcast video and is clearly in the same field as the instant application. Watts et al. similarly provides the distribution of enhanced content with broadcast video. Watts is clearly both in the same field as the instant application as well as the Butler invention. Watts clearly provides the user with flexibility to turn off the supplemental content so as not to be bothered by content if they would prefer to watch the programming without interruption. Accordingly, it is the examiner's position that sufficient motivation has been provided by the references themselves or in the knowledge generally available to one of ordinary skill in the art.

With respect to applicant's arguments such that the Butler specifically teaches away from the present invention as well as the Watts et al. system because it provides a solution which utilizes conventional formats as opposed to Watts et al, the examiner respectfully disagrees. A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighed in substance. The cited passage teaches that Butler et al. utilizes conventional formats for providing ancillary data along with video broadcasts. 'Conventional formats' include MPEG-2. There is absolutely no teaching or suggestion in the Watts et al. reference that precludes or disparages the particular usage of a 'conventional format' similar to that disclosed by Butler et al. (ex. MPEG-2) for the distribution of both video and supplemental content using the disclosed digital satellite distribution system of

Watts et al. For example, DSS/DVB is a conventional video distribution format used by Watts et al. as a means for distribution that is based on the MPEG-2 standard similar to that employed by Butler. Therefore, all of the systems are directed towards digital television distribution and the usage of conventional formats (ex. MPEG). Both Watts et al. and Butler et al. are clearly in the same field of endeavor of each other as well as the instant application namely digital television and video services. Given that the Watts et al. distribution of both video programming and supplemental content can come from the same source such as a digital satellite broadcast and Butler et al. discloses the particular receipt of MPEG in association with digital satellite, why would the combination preclude the usage of a standardized distribution such as MPEG. Furthermore, the referenced "controller 504" is disclosed as being implemented as a broad category of variety of computing devices including conventional desktop computers as well as Internet "appliance" devices (Col 11, Lines 1-14) which in does not preclude its usage in association with the Butler et al. embodiment, nor would the combination of computing logic associated with a computing controller appear to be an unsuitable modification to a computing device such as that provided by Butler et al.

With respect to applicant's arguments such that modifying Butler to require user permission for showing the hyperlink overlays goes against Butler's stated purpose of utilizing conventional formats for providing ancillary data, the examiner respectfully disagrees. Similar to the teachings of Watts et al., supplemental information is distributed to the user irrespective of whether or not the user wants it. The teachings of Watts et al. simply gives the user the ability to further turn the displayed information off. Butler et al. is silent

with respect to any teachings that would dissuade one from a modification so as to temporarily disable or turn off supplemental content. Accordingly, there simply is no basis to conclude that any possible modification to Butler et al. is taught away from by virtue of the reference disclosing the particular usage of standardization for providing ancillary data. By being 'silent', the reference cannot possibly 'teach away' from the proposed combination and in particular one in which only modification being made lies in the ability to turn on/off supplemental received content.

Applicant's arguments pursuant to claim 9 appear to be substantially the same as those previously addressed and are likewise not considered persuasive.

Applicant's arguments pursuant to claim 12 appear to be substantially the same as those previously addressed. As previously discussed, the instant application does not appear to provide any particular basis by which to conclude that a broadcast enabled personal computer or enhanced television is not a 'specialized receiver' in so far as it is capable of receiving multiplexed digital television signals similar to the instant application. Butler et al. clearly enables the simultaneous display of the Banner Information (being defined as contents in the form of text, graphics, images, or any other type of audio/visual information which is intended for commercial advertisement and can be presented to the user with any other type of digital information) with regular programming (Para. [0044]). Taken in combination with Watts in light of the previously discussed teaching, suggestion, or motivation found in the references themselves or in the knowledge generally available to one of ordinary skill in the art, the combination allows for a user to grant permission as to whether or not to display the supplemental content through turning the content on or off. There is nothing to suggest that

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Butler et al. would somehow be rendered unsuitable for its intended purpose simply by providing the user with the option to turn on/off the particular functionality. Therefore, applicant's arguments are not considered persuasive.

Applicants present no additional arguments pursuant to claims 28 and 29 and, as previously discussed, those arguments were not considered persuasive.

Regarding applicant's arguments regarding claims 2-8 and 13-15 and no prima facie case of obviousness having been established, the examiner respectfully disagrees. The Butler et al. reference explicitly discloses the usage of MPEG-2. The instant application concedes that MPEG-2 is a well known standard that allows for consistent and uniform digital video signal sampling, coding, transmission and reception throughout the world and is very well known in the art (IA: Page 2, Line 14 – Page 3, Line 2). There is simply no basis to conclude that the Butler et al. disclosure, which per applicant's previous arguments teaches away from using anything other than standards, would use anything other than the standardized MPEG-2 protocol regardless of the degree of undertaking involved. Accordingly, it is the examiner's position that one would be motivated to utilize the standard, not only in view of its disclosed usage by Butler, but also for the common knowledge purpose of providing consistent and uniform digital video signal sampling, coding, transmission and reception in a manner which is usable throughout the world.

With respect to applicant's arguments regarding the particular usage of an application of the MPEG-2 standard and TS packetization as requiring a substantially undertaking which would not be obvious to those skilled in the art, the examiner respectfully disagrees. As previously noted, applicants disclose that systems designed in accordance with the MPEG-2

standard involving the coding, TS packetizing, multiplexing, and distribution of programs along with audio and video overlays are very well known to the extent that they have proliferated around the world. The particular implementation of MPEG-2 applications of these types of systems is clearly knowledge that is generally available to those skilled in the art. The particular usage of TS packetization in MPEG-2 applications is well known in the art as described in the instant application (IA: Page 18, Lines 18-19). The MPEG-2 standard, of record, also discloses advantages associated with the usage of TS packetization including providing the robustness necessary for noisy channel distribution such as those employed by satellite distribution (Introduction – PART 1 Systems). Butler et al. utilizes satellite distribution. There is no simply no factual basis to conclude that one would not have turned to the MPEG-2 standard and its associated teachings in light of the disclosed usage of MPEG-2 by Butler et al. in order to provide for a consistent and uniform digital video signal sampling, coding, transmission and reception in a manner which is usable throughout the world. Applicant's previous arguments go so far as to conclude that Butler et al. is directed to providing a standardized solution for the distribution of video along with supplemental content. The particular usage of a standard video encoding method that is clearly disclosed in Butler et al. that has been implemented throughout the world does not appear unreasonable in association with providing a standardized solution. Given the highly predictable nature of the video distribution art and the wide usage of MPEG-2, irrespective of the difficulty, one having ordinary skill certainly would have had reasonable expectation of success in association with implementing the MPEG-2 standard irrespective of any purported 'difficulty'.

Regarding applicant's further arguments pertaining to claim 3, the applicant argues that the system fails to utilize any "modulation function". As discussed in the examiner's response to applicant's previous arguments, it has been concluded that a 'modulation function' is an inherent characteristic of the Butler et al. system in association with employing digital satellite broadcasts wherein the digital signals are distributed on multiple RF frequencies or channels (Para. [0013]). Applicants have not met their burden of proof providing an evidentiary showing that the particular distribution of digital satellite broadcast signals on multiple RF frequencies or channels can be performed without modulation. Accordingly, applicant's arguments are not deemed persuasive; however, further evidence with respect to the usage of 'modulation' has been provided via the incorporated co-pending application "Broadcast-Enabled Personal Computer" (Newell).

Responsive to applicant's arguments that the examiner has not taken the proper steps in showing that Newell is qualifying proper prior art and that it is non-analogous prior art, the examiner respectfully disagrees. The Newell reference is explicitly incorporated by reference in the Butler et al. with respect to the particular implementation of the broadcast-enabled PC described in Butler et al. (Para. [0030]). Accordingly, as set forth in MPEP 901.02, 2127, and 2163.07(b), the co-pending (subsequently abandoned) Newell application is properly available as prior art under 102(e). In response to applicant's argument that Newell is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, the Newell reference is in the same field of endeavor namely digital television and video services.

Applicant's arguments pursuant to claim 15 appear to be substantially the same as those previously addressed and are likewise not considered persuasive.

Regarding applicant's additional arguments regarding claims 4-7, 13, 14, and 17-20, applicant's argue that the tuner [60] and the video subsystem [66] of Butler et al. fail to meet the limitations of a several claimed elements. The disclosure of a reference can be express, implicit or inherent. As set forth in the rejection, the noted components have been construed as being necessary or required by the receiver so as to process an MPEG-2 encoded TS digital signal. The Applicants have not met their burden of proof providing an evidentiary showing that the particularly identified components are not necessarily present in Butler et al. Furthermore, the examiner has provided an express showing that these elements are present in the Butler et al. broadcast enabled PC in view of the expressly incorporated Newell reference. Accordingly, applicant's arguments are not deemed persuasive.

Applicants present no further arguments pursuant to claim 8 over and above those previously addressed and not considered persuasive.

Regarding additional arguments regarding the rejection of claims 10 and 11 and the traversal regarding the examiner's conclusion that the applicant's did not adequately/timely traverse the OFFICIAL NOTICE as to the existence of service agreements, the applicant's remarks are noted. As set forth in the previous response, the examiner noted that evidence of record of the noted facts was provided both in three separately qualifying references in addition to a showing in the instant application. No particular arguments are provided with

respect to the three qualifying previously supplied ‘qualifying prior art’ not showing what is purported to be shown for which the examiner can adequately respond. The examiner also noted that applicant’s own disclosure provides evidence as to the particular existence of video distribution services wherein viewers are charged monthly service fees (IA: Page 3, Lines 11-18). The disclosed charging of a monthly service charge is considered to be a service agreement that provides for a limitation on the subscription charged to the end user indicative of the monthly service fee. Where the specification identifies work done by another as “prior art,” the subject matter so identified is treated as admitted prior art. In re Nomiya, 509 F.2d 566, 571, 184 USPQ 607, 611 (CCPA 1975) (holding applicant’s labeling of two figures in the application drawings as “prior art” to be an admission that what was pictured was prior art relative to applicant’s improvement). Per MPEP 2128.02, in the absence of another credible explanation that the subject matter identified is applicant’s own work, or the work of another, examiners should treat such subject matter as the work of another. Applicant’s have provided no evidence on the record that they believe that they are the first and sole inventors of service networks which charge their subscribers service monthly fees; nor have applicant’s provided any basis to conclude that the particular claim elements associated with charging of monthly service fee is not known in the prior art in light of the examiner’s previously presented reasoning and cited references.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 9, 12, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler (US Pub No. 2002/0007493 A1) in view of Watts et al. (US Pat No. 6,324,694 B1).

In consideration of claim 1, Figure 1 of the Butler et al. reference illustrates a “digital video service network” [10] comprising a “means for providing a combined digital signal” [12] having “information reflective of a regular program signal” and a “Banner Information signal” or ancillary data in the form of HTML advertisement overlays (Para. [0004], [0015], and [0020]) via a “channel communicating the combined digital signal from the means for providing a combined digital signal to the receiver” (Para. [0013]). The aforementioned, “combined digital signal” is subsequently “received” via a “receiver” with an associated “presentation unit” or display [68] which “presents . . . the Banner Information . . . with the regular program” (Para. [0004] and [0036]).

With respect to the limitation pertaining to the usage of a “controller”, the Butler et al. reference comprises a “controller” [52] that “controls the presentation unit to display the Banner Information with the regular program”, however the reference is silent with respect to such being performed “upon permission only”. In an analogous art pertaining to interactive distribution systems, the Watts et al. reference discloses a method for distributing video programming and supplemental content including a “controller” [141] that “controls the presentation unit to display [the supplemental content] with the regular program upon permission only” (Watts et al.: Col 2, Line 63 – Col 4, Line 35; Col 5, Lines 28-33; Col 8, Lines 17-29; Col 9, Lines 31-38). Accordingly, it would have been obvious to one having

ordinary skill in the art at the time the invention was made so as to modify Butler et al. so as to further provide the ability for the user so as to enable/disable or to give “permission” to display received supplemental content or “Banner Information” for commonly known advantage of providing the user with improved flexibility with respect to the presentation of supplemental information. For example, such a means may advantageously provide the user with the ability to turn-off “Banner Information” or supplemental content should they desire not to be bothered by such pop-up information.

In consideration of claim 9, Figure 4 of the Butler et al. reference discloses a “method for providing digital television programming to viewers” comprising “creating a combined digital television signal which combines information reflective of regular programming” [220] and “information reflective of Banner Information” [226] which is subsequently “transmitted . . . over a channel” (Para. [0013] and [0050] – [0053]). The aforementioned “transmitted, combined digital signal” is subsequently “received” [230] at a “receiver” [14] (Figure 5) and are “provided to a presentation unit” [68] such that the “information reflective of the regular programming and the information reflective of the Banner Information are displayed simultaneously on the presentation unit” (Para. [0004] and [0036]).

With respect to the limitation pertaining to the usage of a “controller”, the Butler et al. reference comprises a “controller” [52] that “controls the presentation unit to display the Banner Information with the regular program”, however the reference is silent with respect to such being performed “upon permission only”. In an analogous art pertaining to interactive distribution systems, the Watts et al. reference discloses a method for distributing video programming and supplemental content including a “controller” [141] that “controls the

presentation unit to display [the supplemental content] with the regular program upon permission only” (Watts et al.: Col 2, Line 63 – Col 4, Line 35; Col 5, Lines 28-33; Col 8, Lines 17-29; Col 9, Lines 31-38). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify Butler et al. so as to further provide the ability for the user so as to enable/disable or to give “permission” to display received supplemental content or “Banner Information” for commonly known advantage of providing the user with improved flexibility with respect to the presentation of supplemental information. For example, such a means may advantageously provide the user with the ability to turn-off “Banner Information” or supplemental content should they desire not to be bothered by such pop-up information.

Claim 12 is rejected wherein the user is “provided a receiver . . . which specifically enables the simultaneously display of the Banner Information and the regular programming on the presentation unit” in connection with the necessary hardware to receive and decode DBS signals (Para. [0002]). As aforementioned, in light of the combined references the “provided receiver” further “allows the controlling the presentation unit to display the Banner Information with the regular program only upon permission” (Watts et al.: Col 8, Lines 17-29; Col 9, Lines 31-38).

Claim 28 is rejected in light of the Watts et al. reference wherein the “permission” is implicitly “provided by a user who is a viewer of the regular program” (Watts et al.: Col 8, Lines 17-29) given that the user is equated with being a viewer of television programming.

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Claim 29 is rejected in wherein “if there is no permission the controller controls the presentation unit to display the regular program without the Banner Information” (Col 9, Lines 32-39).

4. Claims 2-8 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US Pub No. 2002/0007493 A1) in view of applicant’s admitted prior art (APA) relating to the MPEG-2 Standard.

In consideration of claim 2, the Butler et al. reference discloses that the “regular program and the Banner Information are synchronized” (Para. [0043]) as well as the particular usage of MPEG-2 in connection with the “providing” / distribution [12] of the combined digital signal (Para. [0015]). The reference, however, does not explicitly disclose details associated with the implementation of the standard including the creation of a “TS packetized” stream. Applicant’s admitted prior art discloses that the particular usage of TS packetization as defined in the MPEG-2 Standard is well known in the art (IA: Page 18, Lines 18-20). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to “create a TS packetized combined digital signal” in connection with complying with the MPEG-2 standard for the commonly known advantages associated with such including providing for consistent and uniform digital video signal sampling, coding, transmission and reception of programs along with audio and video overlays (IA: Page 2, Line 16 – Page 3, Line 8) in a manner that provides the robustness necessary for noisy channel distribution such as those employed by satellite distribution (Introduction – PART 1 Systems).

In consideration of claims 3 and 15, as aforementioned, the Butler et al. reference particularly discloses the usage of the MPEG-2 in connection with the distribution of a multiplexed digital signal. The reference, however, does not particularly disclose the details pertaining to the construction of a TS in accordance with the MPEG-2 standard (Para [0015]). Applicant's admitted prior art discloses that the MPEG-2 standard discloses details pertaining to the packetizing, multiplexing and sending of coded bit streams of multiple programs wherein multiple programs with audio and video overlays may be transmitted by a service provider and received by the end user (IA: Page 3, Lines 4-10). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to particularly utilize "a first coding unit for coding the regular program signal and a second coding unit for coding the Banner Information signal, a first TS packetization unit for receiving the coded regular program signal and providing a packetized bit stream reflecting the coded regular program signal and a second TS packetization unit for receiving the coded Banner Information signal and providing a packetized bit stream reflecting the coded Banner Information signal, a TS Packet multiplexer for receiving the packetized regular program signal and the packetized Banner Information signal and providing a multiplexed transport stream" for the purpose of providing a means so as to facilitate the encoding, packetizing, multiplexing, and providing of an MPEG-2 TS in accordance with the MPEG-2 standard and the associated inherent advantages associated with such including the ability to distribute multiple programs along with audio and video overlays with improved error resilience plus the ability to carry these programs simultaneously without requiring a common time base.

With respect to the particular limitation of a “channel modulation unit for modulating the transport stream into the combined digital signal and sending the combined digital signal for transmission to the channel”, the Butler et al. reference requires the particular usage of such given that the receiver utilizes a particular channel for the reception of the combined stream (Para. [0032]) and the source distributes the content over a particular channel (Para. [0013]). Further evidence is provided in light of co-pending application no. 08/503,055 (hereafter, Newell et al.) explicitly incorporated by reference which illustrates the particular usage of QPSK modulation [47] in association with the received signal (Figures 3 A/B).

In consideration of claims 4-7, 13, and 14, as aforementioned the Butler et al. reference discloses the particular usage of the MPEG-2 standard in connection with the processing of the received data wherein the particular utilization of a “TS packetized” streams in accordance with the standard would have been an obvious modification in order to provide the robustness necessary for noisy channels distribution channels such as those employed by satellite distribution. As illustrated in Figure 2, the “receiver” [14] is and “comprises a specialized receiver” for the reception and processing of digital television signals alongside ‘Banner Information’ that further implicitly employs the claimed means for the purpose of demodulating, demultiplexing, depacketizing, decoding, and rendering an MPEG-2 packetized TS for the purpose of rendering the received MPEG-2 TS in accordance with the MPEG-2 standard. In particular, as further illustrated in Figures 3/A and 4 of the incorporated Newell et al. reference, the receiver comprises a “channel demodulation unit for demodulating the received combined digital signal and extracting bit streams of the regular program signal and the Banner Information signal from a user-tuned channel” [47], “a TS

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demultiplexing unit for demultiplexing the regular program bitstream and Banner Information TS packets from the signal received from the channel demodulation unit” [45/45’], “a Banner Information TS depacketizer for receiving the Banner Information TS packets from the TS demultiplexing unit and depacketizing the Banner Information TS packets to provide a coded Banner Information signal” [45/45’], “a Rendering Unit for decoding and rendering the coded Banner Information into a bitmap video signal” [94], “a video reconstruction unit for receiving the rendered Information bitmap video signal and creating an output for the presentation device” [92], “Audio/video decoders for receiving the regular program bitstream from the TS demultiplexing unit . . . decoding audio and video coded bit streams of the regular program signal . . . [and] sending an Audio output signal for transducing into sound and a decoded video signal to the video reconstruction unit” [94/98], “the video reconstruction unit reconstructing an output video signal from the decoded video output and the rendered Banner Information bitmap video signal . . . [and] sending the video output signal . . . to the video presentation device” [46] for “display where the regular program and the Banner Information are displayed simultaneously” (Butler et al.: Para. [0032] – [0039]).

In consideration of claim 8, the claimed limitation do not set forth any over and above those addressed in the combined rejections of claims 1, 3, and 4 and is accordingly rejected as previously set forth. In particular, Figure 1 of Butler et al. illustrates a “digital video service network” [10] comprising a “means for providing” [12], a “receiver” [14], and a “channel for communicating the combined digital signal from the means for providing” (Para. [0013]). As aforementioned, while Butler et al. provides a “controller” [52] that

“controls the video reconstruction unit to display the Banner Information with the regular program”, the reference is silent with respect to such being performed “upon permission only”. In an analogous art pertaining to interactive distribution systems, the Watts et al. reference discloses a method for distributing a “combined digital signal having information reflective of a regular program signal and a Banner Information signal” including a “controller” [141] that “controls the video reconstruction unit to display the Banner Information with the regular program upon permission only” (Watts et al.: Col 2, Line 63 – Col 4, Line 35; Col 5, Lines 28-33; Col 8, Lines 17-29; Col 9, Lines 31-38). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify Butler et al. so as to further provide the ability for the user so as to enable/disable or to give “permission” to display received supplemental content for commonly known advantage of providing the user with improved flexibility with respect to the presentation of supplemental information. For example, such a means may advantageously provide the user with the ability to turn-off “Banner Information” or supplemental content should they desire not to be bothered by such pop-up information.

5. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US Pub No. 2002/0007493 A1) in view of applicant’s admission of fact (AAF).

In consideration of claims 10 and 11, the Butler et al. reference does not explicitly disclose the particular usage of “entering into an agreement with end-users which allows for” the aforementioned “simultaneous display of the Banner Information and the regular programming on the presentation unit” wherein “the agreement provides for a limitation on the subscription charged to the end user. Applicant’s admission of fact provides evidence as

to the existence of service agreements (ex. quarterly/monthly/yearly subscriptions) that “allow” viewers to watch distributed programming and “provide for a limitation on the subscription charged to the end user” is notoriously well known in the art of video distribution (ex. IA: Page 3, Lines 14-17). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Butler et al. so as to employ the aforementioned service agreements for the inherent advantages associated with such including the ability of the service provider to profit or recoup costs associated with the distribution of video programming.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Armstrong et al. (US Pat No. 7,017,173 B1) reference discloses a system and method for the particular display of advertising information and video programming simultaneously wherein the advertising and the video programming and delivered together as a multiplexed MPEG-2 transport stream.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until

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after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SEB
August 11, 2006

Scott Beliveau
Primary Examiner
Art Unit 2623